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| 10/036,170 | 12/31/2001 | Irvin B. Watts | G07.009 | 4831 |
| 28062 | 7590 | 11/17/2005 | EXAMINER | |
| BUCKLEY, MASCHOFF, TALWALKAR LLC | | | VAN BRAMER, JOHN W | |
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| NEW CANAAN, CT 06840 | | | PAPER NUMBER | |

3622

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/036,170

Applicant(s)

WATTS ET AL.

Examiner

John Van Bramer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☒ Claim(s) 43-49 and 51 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 062502.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Objections

1. The Claims 43-49 are objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o).

Correction of the following is required:

Claims 43-49 make references to "said second date"

- a. Claim 43, lines 6,9,10
- b. Claim 46, line 3
- c. Claim 48 line 1
- d. Claim 49 lines 1-2

No previous indication of what second date this refers to is provided in independent claim 43. The Examiner has interpreted claim 43, lines 5-7 to read as providing a notification to said customer indicative of availability of an increase to said monetary amount at a second date and a criterion associated with said increase to said monetary amount where in the second date is a new date that is sometime after the first date and sometime on or before the activation date. The claims have been prosecuted with this interpretation.

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2. Claims 43 and 51 are objected to because of the following informalities:

Claim 43: On line 6 of claim 43 the word "an" appears to be a typographical error. The examiner has substituted the word "and" in place of "an" in this line. The claim was prosecuted with this interpretation.

Claim 51: The manner in which the claim has been constructed may leave some doubt as to its status as statutory material and therefore its patentability under 35 USC 101. As such, the Examiner is interpreting the claim to mean – a computer readable medium containing a computer program product with instructions causing the system to be executed to provide benefit to a customer. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-15, ¹⁷~~16~~-21, 23-29, 31-47, 50-51 are rejected under 35 U.S.C. 102(b) as being anticipated by Ferguson et al. (U.S. Patent Number: 5,991,736).

Claim 1: Ferguson discloses a method for providing a benefit to a customer, comprising:

- a. Establishing an account for a customer. (Col 7, lines 8-62)

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- b. Allowing said customer to increase a first benefit associated with said account, wherein said customer cannot use said first benefit until an activation date associated with said account. (Col 11, lines 23-35)
- c. Associating a second benefit with said account at said activation date. (Col 11, lines 23-35)
- d. Allowing said customer to use said first benefit and said second benefit after said activation date. (Col 11, lines 23-35)

Ferguson discloses that the account can be an IRA. IRA's have strict government regulations on when the money invested in an IRA may be withdrawn (i.e. When the account can be activated). Thus it is inherent that the benefits in the IRA account in Ferguson cannot be used until the regulated activation date.

Claim 2: Ferguson discloses a method of claim 1, wherein said establishing an account for a customer includes at least one of the following: associating an account identifier with said customer; providing a notice of said account to said customer; providing a notice of said account to a merchant associated with said account; establishing said account with a zero monetary balance; and establishing said account with a non-zero monetary balance. (Col 7, lines 8-62 and Col 8, lines 28-61)

Claim 3: Ferguson discloses a method of claim 1, wherein said allowing said customer to increase a first benefit associated with said account, wherein said customer cannot use said first benefit until an activation date associated with said account includes at least one of the following: allowing said customer to associate a monetary

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amount with said account; allowing said customer to provide money and associating said money with said account; allowing said customer to make a money deposit, said deposit being associated with said account; allowing said customer to increase a zero monetary balance initially associated with said account; and allowing said customer to add to a non-zero monetary balance initially associated with said account. (Col 11, lines 23-35)

Claim 4: Ferguson discloses a method of claim 1, wherein said associating a second benefit with said account at said activation date includes at least one of the following: increasing a monetary amount associated with said account; increasing a monetary amount associated with said account in proportion to increases to said monetary amount added by said customer; and increasing a monetary amount associated with said account by a predetermined percentage of increases to said monetary amount added by said customer. (Col 12, lines 3-49)

Claim 5: Ferguson discloses a method of claim 1, wherein said allowing said customer to use said first benefit and said second benefit after said activation date includes at least one of the following: allowing said customer to receive said first benefit after said activation date; allowing said customer to receive said second benefit after said activation date; allowing said customer to receive any monetary amounts associated with said account after said activation date; and allowing said customer to use any monetary amounts associated with said account after said activation date. (Col 11, lines 23-35 and Col 3, lines 24-45)

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Claim 6: Ferguson discloses a method of claim 1, further comprising:
determining said activation date. (Col 5, lines 41-59 and Col 11, lines 23-35)

Claim 7: Ferguson discloses a method of claim 1, wherein said first benefit is a
monetary amount. (Col 11, lines 23-35)

Claim 8: Ferguson discloses a method of claim 1, further comprising: identifying
said customer. (Col 8, lines 28-61)

Claim 9: Ferguson discloses a method of claim 1, further comprising: providing a
notification to said customer indicative of an availability of said account. (Col 1, lines 7-
17, and Col 1, lines 33-47)

Claim 10: Ferguson discloses a method of claim 1, further comprising: providing
a notification to said customer indicative of availability of said second benefit. (Col 1,
lines 7-17; Col 1, lines 33-47; and Col 7, line 63 through Col 8, line 22)

Claim 11: Ferguson discloses a method of claim 1, further comprising: providing
a notification to said customer indicative of said activation date. (Col 3, lines 9-15; Col 3,
lines 24-45; and Col 11, lines 23-35)

Claim 12: Ferguson discloses a method of claim 1, further comprising:
determining said second benefit. (Col 12, lines 50-63 and Col 12, lines 3-32)

Claim 13: Ferguson discloses a method of claim 1, wherein said second benefit
is a monetary amount. (Col 12, lines 50-63)

Claim 14: Ferguson discloses a method of claim 1, further comprising: providing at least one notification to said customer of an accumulated benefit associated with said account prior to said activation date and after said account is established. (Col 13, lines 42-65)

Claim 15: Ferguson discloses a method of claim 1, wherein said first benefit is associated with said account by said customer. (Col 11, lines 23-35)

Claim 17: Ferguson discloses a method of claim 1, wherein said account has a zero initial benefit until such time as said customer associates said first benefit with said account. (Col 11, lines 23-35)

Claim 18: Ferguson discloses a method of claim 1, further comprising: associating said account with a merchant. (Col 11, lines 23-35)

Claim 19: Ferguson discloses a method of claim 18, further comprising: allowing said merchant to provide said second benefit. (Col 11, lines 23-35 and Col 12, lines 50-63)

Claim 20: Ferguson discloses a method of claim 18, further comprising: allowing said merchant to associate a third benefit with said account. (The third benefit being promotional advertising contained in monthly reports) (Col 13, lines 42-65)

Claim 21: Ferguson discloses a method of claim 1, wherein said account has an associated termination date. (Col 3, lines 9-15; Col 3, lines 24-45; and Col 11, lines 23-35)

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Claim 23: Ferguson discloses a method of claim 1, further comprising: providing a notice of said account to a merchant associated with said account. (Col 13, lines 42-65)

Claim 24: Ferguson discloses a method of claim 1, further comprising: identifying a merchant associated with said account. (Col 11, lines 47-53)

Claim 25: Ferguson discloses a method for providing a benefit to a customer, comprising:

- a. Establishing an account for a customer on a first date, wherein said account has an associated monetary amount and said customer cannot decrease said monetary amount until a second date. (Col 7, lines 8-62)
- b. Allowing said customer to increase said monetary amount after said first date. (Col 11, lines 23-35)
- c. Increasing said monetary amount at said second date. (Col 11, lines 23-35 and Col 12, lines 50-63)
- d. Allowing said customer to decrease said monetary amount associated with said account after said second date. (Col 11, lines 23-35)

Ferguson discloses that the account can be an IRA. IRA's have strict government regulations on when the money invested in an IRA may be withdrawn (i.e. When the account can be activated). Thus it is inherent that the benefits in the IRA account in Ferguson cannot be used until the regulated activation date.

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Claim 26: Ferguson discloses a method of claim 25, further comprising:
determining a merchant associated with said account. (Col 11, lines 23-46 and Col 13, lines 42-65)

Claim 27: Ferguson discloses a method of claim 26, further comprising:
providing a notification of said account to said merchant. (Col 11, lines 23-46 and Col 13, lines 42-65)

Claim 28: Ferguson discloses a method of claim 26, further comprising:
providing a notification of said merchant to said customer. (Col 11, lines 23-46 and Col 13, lines 42-65)

Claim 29: Ferguson discloses a method of claim 25, wherein said allowing said customer to decrease said monetary amount associated with said account after said second date includes at least one of the following: allowing said customer to receive said monetary amount after said second date; and allowing said customer to use said monetary amount after said second date. (Col 3, lines 9-15; Col 3, lines 24-45; and Col 11, lines 23-35).

Claim 31: Ferguson discloses a method of claim 25, further comprising:
determining said second date. (Col 7, lines 8-62)

Claim 32: Ferguson discloses a method of claim 25, further comprising:
providing a notification to said customer of said second date. (Col 11, lines 23-35 and Col 13, lines 42-65)

Claim 33: Ferguson discloses a method of claim 25, further comprising:
providing a notification to said customer of an availability of an increase to said
monetary amount. (Col 13, lines 42-65)

Claim 34: Ferguson discloses a method of claim 25, further comprising:
providing a notification to said customer of an availability of an increase to said
monetary amount and at least one criterion that must be met for said customer to obtain
said increase. (Col 12, lines 3-63)

Claim 35: Ferguson discloses a method of claim 25, further comprising: offering
said account to said customer. (Col 1, lines 7-17, and Col 1, lines 33-47)

Claim 36: Ferguson discloses a method of claim 25, further comprising:
selecting said customer. (Col 1, lines 7-17; Col 1, lines 33-47; and Col 4, lines 8-15)

Claim 37: Ferguson discloses a method of claim 25, further comprising:
providing at least one notification to said customer indicative of a monetary amount
associated with said account. (Col 13, lines 42-65)

Claim 38: Ferguson discloses a method of claim 25, further comprising:
associating said account with a merchant. (Col 11, lines 23-35)

Claim 39: Ferguson discloses a method of claim 38, further comprising: allowing
said merchant to increase said monetary amount. (Col 12, lines 50-64)

Claim 40: Ferguson discloses a method of claim 38, further comprising: allowing
said merchant to associate a benefit with said account. (Col 12, lines 3-49)

Claim 41: Ferguson discloses a method of claim 25, further comprising:
determining how much to increase said monetary amount at said second date. (Col 12, lines 3-49)

Claim 42: Ferguson discloses a method of claim 25, wherein said account has a zero monetary amount associated with it until such time as said customer increases said monetary amount. (Col 11, lines 23-35)

Claim 43: Ferguson discloses a method for providing a benefit to a customer, comprising:

- a. Establishing an account for a customer on a first date, wherein said account has an associated monetary amount and said customer cannot decrease said monetary amount until an activation date. (Col 7, lines 8-62)
- b. Providing a notification to said customer indicative of availability of an increase to said monetary amount benefit at said second date an a criterion associated with said increase to said monetary amount. (Col 7, lines 8-62 and Col 12, lines 3-63)
- c. Allowing said customer to increase said monetary amount after said first date and before said second date. (Col 11, lines 23-35)
- d. Increasing said monetary amount at said second date if said customer satisfies said criterion. (Col 12, lines 3-63)

- e. Allowing said customer to decrease said monetary amount after said activation date. (Col 11, lines 23-35)

Ferguson discloses that the account can be an IRA. IRA's have strict government regulations on when the money invested in an IRA may be withdrawn (i.e. When the account can be activated). Thus it is inherent that the benefits in the IRA account in Ferguson cannot be used until the regulated activation date.

Claim 44: Ferguson discloses a method of claim 43, further comprising: determining if said customer has satisfied said criterion. (Col 12, lines 3-62)

Claim 45: Ferguson discloses a method of claim 43, further comprising: determining said criterion. (Col 12, lines 3-62)

Claim 46: Ferguson discloses a method of claim 43, further comprising: determining an amount to increase said monetary amount at said second date. (Col 12, lines 3-62)

Claim 47: Ferguson discloses a method of claim 43, wherein said account has zero monetary amount associated with it until such time as said customer increases said monetary amount. (Col 11, lines 23-35)

Claim 50: Ferguson discloses a system for providing a benefit to a customer, comprising:

- a. A memory. (Col 7, lines 3-62)

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- b. A communication port. (Col 7, lines 3-62)
- c. A processor connected to said memory and said communication port, said processor being operative to
 - i. Establish an account for a customer. (Col 7, lines 3-62)
 - ii. Allow said customer to increase a first benefit associated with said account, wherein said customer cannot use said first benefit until an activation date associated with said account. (Col 7, lines 3-62)
 - iii. Associate a second benefit with said account at said activation date. (Col 7, lines 3-62)
 - iv. Allow said customer to use said first benefit and said second benefit after said activation date. (Col 7, lines 3-62)

Ferguson discloses that the account can be an IRA. IRA's have strict government regulations on when the money invested in an IRA may be withdrawn (i.e. When the account can be activated). Thus it is inherent that the benefits in the IRA account in Ferguson cannot be used until the regulated activation date.

Claim 51: Ferguson discloses a computer program product in a computer readable medium for providing a benefit to a customer, comprising:

- a. First instructions for associating an account with a customer. (Col 11, lines 23-35)
- b. Second instructions for increasing a first benefit associated with said account, wherein said customer cannot use said first benefit until an activation date associated with said account. (Col 11, lines 23-35)
- c. Third instructions for adding a second benefit to said account at said activation date. (Col 11, lines 23-35)
- d. Fourth instructions for granting use by said customer to said first benefit and said second benefit after said activation date. (Col 11, lines 23-35)

Ferguson discloses that the account can be an IRA. IRA's have strict government regulations on when the money invested in an IRA may be withdrawn (i.e. When the account can be activated). Thus it is inherent that the benefits in the IRA account in Ferguson cannot be used until the regulated activation date.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 16, 22 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson et al. (U.S. Patent Number: 5,991,736) in view of Davies, Chris ("American No-How" Marketing Tools, 10764879, May 97, Vol 4, Issue 4).

Claim 16: Ferguson discloses a method of claim 1, wherein said account is used to transfer a monetary benefit to a customer account (Col 7, lines 7-62). Ferguson implies that the account is already an established account in which the customer normally utilizes for retirement savings (Col 11, lines 23-35). Ferguson is silent with regard to those customers that have not previously established a retirement account in which to deposit funds. Davies, however, discloses that retailers are moving into the financial service marketplace and are beginning to market a full range of bank services (Page 2, par 11). It would have been obvious to one having ordinary skill in the art at the time the invention was made to allow a customer to create a retirement account, that has a zero initial benefit into which funds could be transferred, for those customers that have no previous account with which the system can interact. One would have been motivated to provide the ability to establish new retirement accounts in order to provide customers that do not previously have a retirement savings account the ability to take advantage of the incentive savings plan and generate additional customer loyalty.

Claim 22: Ferguson discloses a method of claim 1, but does not explicitly disclose that the said second benefit is based on an increased amount of said first benefit provided by said customer. However, Davies discloses a method wherein said first benefit is a deposit to a savings account sponsored by the merchant and said second benefit is a higher interest rate on the savings account than normally paid by a bank (Davies, Page 2,

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par 9). It would have been obvious to one of ordinary skill at the time of the invention to offer customers a merchant sponsored retirement savings account that offers a higher interest rate as a second benefit. One would have been motivated to do this in order to generate additional customer goodwill and thereby increasing customer loyalty by offering higher interest rates than those offered elsewhere and providing the customer with an additional reason to frequent the merchants establishment (i.e. making deposits to their retirement savings account).

Claim 30: Ferguson discloses a method of claim 25, wherein said account is used to transfer a monetary benefit to a customer account (Col 7, lines 7-62). Ferguson implies that the account is already an established account in which the customer normally utilizes for retirement savings (Col 11, lines 23-35). Ferguson is silent with regard to the balance of the monetary account when it is first established. Davies, however, discloses that retailers are moving into the financial service marketplace and are beginning to market a full range of bank services (Page 2, par 11). It would have been obvious to one having ordinary skill in the art at the time the invention was made to allow a customer to create a retirement account that has a zero initial balance in which funds could be transferred for those customers that have no previous account with which the system can interact. One would have been motivated to provide the ability to establish new retirement accounts in this manner so as to provide customers without a retirement savings account the ability to take advantage of the incentive savings plan and generate additional customer loyalty.

7. Claims 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson et al. (U.S. Patent Number: 5,991,736).

Claim 48: Ferguson discloses a method of claim 43, wherein an incentive award amount is transferred to an incentive award pool and then to a customer retirement account (Col 12, lines 50-63). However, Ferguson does not explicitly disclose the date in which the award is transferred in relationship to the activation date (customer expected retirement date). It would have been obvious to one having ordinary skill in the art at the time the invention was made to allow for delayed transfer of monetary funds until such time as the customer could actually benefit from the funds. One would have been motivated to allow for this option in order to provide the merchant with the ability to earn interest on the funds and thereby minimize the overhead cost generated by implementing and running the loyalty incentive program.

Claim 49: Ferguson discloses a method of claim 43, wherein an incentive award amount is transferred to an incentive award pool and then to a customer retirement account (Col 12, lines 50-63). However, Ferguson does not explicitly disclose the date in which the award is transferred in relationship to the activation date (customer expected retirement date). It would have been obvious to one having ordinary skill in the art at the time the invention was made to allow for transfer of the monetary funds prior to the activation date(customers expected retirement date) so that customers see their retirement account increasing as additional purchases are made from the

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merchant. One would have been motivated to allow for this option in order to provide the merchant with the ability to balance the benefits of using interest earned on the monetary pool to minimize overhead with the customers need to see the benefits actually transferred to their retirement account as they continue participating in the loyalty incentive program.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Ogilvie (U.S. Patent Number: 6,631,358) which discloses a method for using consumer-initiated transactions to generate incremental monetary incentives that are transferred to a variety of savings instruments.

b. Loveland (PGPUB US 2002/0052818 A1) which discloses another method for acquiring equity from the purchase of goods and services.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is (571) 272-8198. The examiner can normally be reached on 9am - 5pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

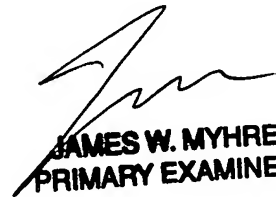
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jvb

jvb

November 9, 2005


JAMES W. MYHRE
PRIMARY EXAMINER